



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Khurshed Mazhar, et al.) Attorney Docket 03797.80030
Appln. No.: 09/411,171)
Group Art Unit: 2756
Filed: October 1, 1999)
Examiner: Unknown
For: Windows Radio Toolbar)

**REQUEST FOR RECONSIDERATION OF PETITION UNDER
37 C.F.R. § 1.47(a)**

Assistant Commissioner for Patents
Washington, D.C. 20231

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Attn.: **BOX DAC, OFFICE OF PETITIONS**

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Sir:

Applicant respectfully requests reconsideration of the previously submitted Petition under 37 C.F.R. § 1.47(a) and reconsideration of the Decision Refusing Status under 37 C.F.R. § 1.47(a) mailed December 26, 2001.

Applicant appreciates the courtesy extended to their representative by the Petitions Attorney, Mr. Tannouse, during a telephone conference on February 11, 2002 relating to this matter. Mr. Tannouse's helpful insights and suggestions were greatly appreciated. This response reflects the discussion during that telephone conference.

As brief background, Applicant filed this application pursuant to 37 C.F.R. § 1.47(a) because one of the joint inventors, Kevin Warne, could not be located to sign the Declaration. Mr. Warne was a consultant engaged by the Applicant, and at the time this patent application was filed, Applicant did not have contact information for Mr. Warne and was unable to locate him to sign the Declaration. The U.S. PTO has accepted Applicant's showing that it has been unable to locate Mr. Warne, and it has granted Applicant's Petition requesting waiver of the rule requiring Applicant to provide a last known address for Mr. Warne. See Paper No. 11, the U.S.

PTO's Decision on Petition under 37 C.F.R. § 1.183 and Refusing Status under 37 C.F.R. § 1.47(a) dated April 19, 2001.

The only issue remaining regarding Applicant's Petition to be accorded status under 37 C.F.R. § 1.47(a) concerns an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. See Paper No. 16, Decision Refusing Status under 37 C.F.R. § 1.47(a) dated December 26, 2001. Because Mr. Warne was not an employee of Applicant (he was a consultant engaged by Applicant and employed by Harris & Associates¹), Applicant was unable to positively state the citizenship of Mr. Warne on the Declaration submitted with the Petition under 37 C.F.R. § 1.47(a).² To date, the U.S. PTO has refused to accept the Declaration and to accord the application status under 37 C.F.R. § 1.47(a) because the Declaration does not identify the citizenship of Mr. Warne. The U.S. PTO views the requirement to identify the citizenship of each inventor as a non-waivable requirement of the Patent Statute.

The Patent Statute provides a mechanism through which patent applications can be filed by a party having a sufficient proprietary interest in the subject matter when one or more inventor cannot be located and/or refuses to sign the necessary papers. See 35 U.S.C. § 118. In such situations, the Statute allows the oath or declaration to be modified so that the parties making the declaration can properly sign it. Specifically, 35 U.S.C. § 115 states, in pertinent part:

35 U.S.C. § 115 - Oath of Applicant

... When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

Pursuant to 35 U.S.C. §§ 115 and 118 and its Petition under 37 C.F.R. § 1.47(a), Applicant submits a new Declaration form signed by three of the four joint inventors. As previously instructed by the U.S. PTO (see the Decision on Petition dated June 20, 2000), the signature block for Mr. Warne has been left blank, but the Declaration identifies him as an inventor. Additionally, the Declaration states that, to the best of the knowledge and belief of the remaining joint inventors who have signed the Declaration, Mr. Warne is a citizen of the United

¹ See the Declaration of D. Bartley Eppenauer filed with Applicant's Petition on November 6, 2000.

² The Declaration of D. Bartley Eppenauer filed November 6, 2000 also confirms that Mr. Warne's previous employer, Harris & Associates, would not provide further information regarding Mr. Warne.

States. As noted above, in Paper No. 11, the U.S. PTO waived the requirement that Applicant provide a last known address and residence for Mr. Warne.

Applicant respectfully submits that this Declaration, in combination with the previously submitted Petition and supporting evidence, fulfill the requirements of the U.S. PTO and places the application in form to be accorded status under 37 C.F.R. § 1.47(a). Based on the telephone conference with Mr. Tannouse, Applicant also believes that this Declaration will be acceptable to the U.S. PTO. Accordingly, Applicant respectfully requests that the U.S. PTO grant its previously submitted Petition and that this application be accorded status under 37 C.F.R. § 1.47(a). Applicant also requests that the application be forwarded to the appropriate examining group for action on the merits.

Any fees that may be required to facilitate entry and consideration of this Request for Reconsideration, such as fees under 37 C.F.R. §§ 1.16 or 1.17, may be charged to Deposit Account No. 19-0733. If an extension of time is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The necessary extension fee also may be charged to Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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Date: April 26, 2002

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